

REMARKS

This Amendment/Response is in response to the Office action (Paper No. 20090501) mailed 12 May 2009.

Listing of The Claims

Pursuant to 37 CFR §121(c), the claim listing, including the text of the claims, will serve to replace all prior versions of the claims, in the application.

Status of The Claims

Claims 1 through 20 are pending in this application. Claims 5-7 are withdrawn from the Examiner's consideration.

Amendment of The Claims

Claims 1-6 and 8-12 are currently amended. Claims 13 through 20 are added. New claim 13 is supported on page 6, lines 12-13 of the specification. The remaining amendments are editorial.

No new matter has been added.

Specification

The specification and Abstract are objected to by the Examiner. Applicant here attaches a substitute specification and abstract which addresses the Examiner's objections. No new matter is added by the substitute specification.

Claim Objections

The claims are objected to because they include reference characters which are not enclosed within parentheses. The claims are currently amended to address this objection.

Regarding Claim 9, the term “injection” is objected to as being grammatically incorrect. Claim 9 is currently amended to address this objection.

Claim Rejections – 35 USC § 112

Claims 1-4 and 8-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention (paragraphs 12-26 of the Office Action).

With regard to paragraphs 12-18, the claims are currently amended to address the Examiner’s assertions in these paragraphs.

With regard to paragraph 19, the Examiner asserts that the term “drilling” in claims 1 and 3 is indefinite. Applicants respectfully traverse. Applicants here attach a copy of a definition for the term “drill” from the Merriam-Webster Unabridged Dictionary (2005). Definition 1(c) states as follows: “to drive a hole in, puncture, or perforate as if with a drill : pierce, penetrate, or drive deep into the interior of”. Accordingly, the term has a commonly recognized definition which is consistent with the terms use in the present application. Withdrawal is respectfully requested.

With regard to paragraph 20, claim 2 is currently amended to address this assertion.

With regard to paragraph 21, the Examiner asserts that the phrase “and/or” renders claim 2 indefinite. Applicants respectfully traverse. Applicants submit that one of ordinary skill in the art would recognize that the agitator can be rotating while moving up and down. Therefore, the term “and/or” is appropriate and clear. Withdrawal is respectfully requested.

With regard to paragraphs 22-26, the claims are currently amended to address the Examiners assertions in these paragraphs.

Claim Rejections – 35 USC § 103

A. Claims 1-3 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hongqi (CN Pub. No. 1209299) in view of Hebrank (US 6,244,214) and Hansen (US 2,316,861).

B. Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hongqi CN '299 in view of Hebrank '214 and Hansen '861 as applied to claims 1 and 8 above, and further in view of Yasuashi (JP 61-141864).

Applicants respectfully traverse each of these rejections.

1. *The Present Invention*

The present invention is directed to a method of manufacturing a processed raw egg having an edible composition. The method comprises cleaning and sterilizing a raw egg (E) with cleaning water and sterilizing, drilling to form an injection hole (Ef) in the upper portion of the egg-shell (Ea) of the raw egg (E), wherein the raw egg (E) is fixedly erected and pressure is exerted on the upper portion of the long axis of the raw egg by means of a drilling and injection tube such that an injection hole is formed. The method includes injecting an edible composition (P) by penetrating a drilling and injection tube (42) inside the raw egg (E) through the injection hole (Ef) of the raw egg (E), and a raw egg agitation step of agitating the edible composition (P) and the viscous albumen (Eb) and yolk (Ed) using an agitating means inserted through the injection hole (Ef) of the raw egg (E).

2. *Distinctions between the present invention and cited art*

Hongqi discloses a process for making an egg with various flavors, which includes using an injector to inject a liquid flavoring material into an egg, shaking the egg, and then boiling and cooking the egg, and lastly placing the egg into cold water. See Hongqi, English Abstract. Applicants also note that, in Hongqi, the boiling of the egg is necessarily performed after the liquid flavoring material is injected into the egg. Further, in Hongqi it is clear that cooking the egg after injection is required since this is the disclosed means by which the hole from the injector is sealed. Hongqi also expressly mentions that the egg contents are agitated by shaking.

Hebrank discloses a method of injecting a substance into bird eggs with a needle and then detecting with a detector information from inside the egg. Hebrank only mentions injecting a

dye, or some type of liquid pharmaceutical or bio-pharmaceutical composition into the eggs. See Hebrank, col. 4, lines 13-18.

Hansen is directed to a method of scrambling an egg while the egg is still within the shell. The method includes breaking the egg with a shank and then inserting blades into the egg and thoroughly mixing the egg. The egg is then removed from the device and broken open, making available the scrambled contents of the egg. The method of Hansen uses a large shank, and necessarily involves breaking the egg and removing the scrambled contents of the egg from inside the egg for use in cooking.

With regard to claims 1-3 and 8-10, the prior art, taken individually or in combination, does not disclose or suggest all of the steps of claim 1-3 and 8-10. For example, the prior art does not disclose or suggest agitating an edible composition inside an egg using an agitating means as presently claimed.

The Examiner asserts that Hongqi teaches mixing the contents of an egg, but then states that Hongqi does not mention how the mixing is accomplished. Hongqi, in fact, clearly states in the Abstract that the mixing is accomplished by “shaking the egg”. Nevertheless, the Examiner then cites Hansen for the disclosure of agitating an egg through a hole in the egg.

Hansen, however, cannot be properly combined with Hongqi because the method of Hansen includes the formation of a large hole in the top of the egg (as shown in the Figures), then mixing with an egg beater, and then breaking the egg and removing the scrambled contents of the egg from the egg shell. The method of Hongqi does not involve breaking the egg and removing the contents of the egg from the shell. There is no credible assertion in the Office Action or in the prior art, that the drilling and agitation steps of Hansen could be used in any method other than a method that includes breaking the egg and removing the scrambled contents for further use.

Accordingly, Hansen cannot be combined with Hongqi. The presently claimed step of agitating the contents of the egg is not disclosed or suggested by the prior art. See MPEP §2143.01(V) (“If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the

proposed modification.”). See also, MPEP §2143.01(VI) (“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.”). This rejection must be withdrawn.

With regard to claims 4, 11, and 12, the prior art does not disclose or suggest injecting an edible composition into a raw egg that includes grains, fruits, vitamins, etc. as recited in present claims 4, 11 and 12. The Examiner asserts Hongqi in this regard for the teaching of injecting a liquid flavoring material into an egg. A liquid flavoring material, however, can in no way be considered the equivalent of a fruit, grain, carbohydrate, vitamin, or any of the other items mentioned in claims 4, 11, and 12. The liquid flavoring material in Hongqi is clearly only enhances the flavor of the egg composition itself. The present claims 4, 11 and 12 are directed to adding new edible compositions into the egg.

Claim 4 also recites that a part of the contents of the egg is removed and replaced with the edible composition. The Examiner asserts that Hebrank teaches that material can be removed from an egg by their method. Hebrank, however, is clearly directed to injecting various pharmaceutical and biological compositions for the purpose of later detection and/or testing. See e.g., the Abstract, and the disclosure throughout. Hebrank states at col. 3, lines 6-7, that the method can withdraw “biological material from a particular location” in an egg. This is manifestly distinct, and not the equivalent of removing a part of the contents of the egg, and then replacing the removed contents with an edible composition. Hebrank does not disclose or suggest removing and replacing contents of an egg with an edible composition.

The Examiner also asserts Yasuashi in regard to claims 4 and 12. However, Yasuashi, like Hansen, discloses creating a large hole in the top of the egg of several mm, pouring a food material different from the egg into the egg, and then sealing the hole with tape. Yasuashi also does not mention agitating with an agitating means as presently claimed. Yasuashi therefore cannot be combined with Hongqi to create a case of *prima facie* obviousness since the principle of operation of Yasuashi is completely different from that of Hongqi. The proposed modification of Hongqi by Yasuashi (as in the case of the combination with Hansen) would

render the prior art unsatisfactory for its intended purpose, and would change the principle of operation of Hongqi by requiring a large hole, and sealing it with tape. See MPEP §2143.01. Further, Yasuashi requires cooking the egg unlike present claims 4, 11 and 12. Accordingly, Yasuashi cannot be combined with Hongqi to arrive at the present invention. Claims 4, 11 and 12 are therefore allowable.

With regard to new claim 13, the prior art does not disclose or suggest a cleaning and sterilizing step before forming an injection hole. The Examiner asserts that the boiling disclosed by Hongqi is equivalent to the step of cleaning and sterilizing since it is known that boiling is an effective means of sterilization. Office Action, paragraph 30. However, the presently recited cleaning and sterilization step of claim 13 is performed before a hole is drilled in the egg and an edible composition injected therein. Hongqi discloses injecting a liquid flavoring material through the egg shell and then boiling as a means of cooking the egg to coagulate the interior contents of the egg in order to seal the hole.

The boiling step of Hongqi therefore cannot be considered the equivalent of a cleaning and sterilizing step as presently claimed, since it is performed after the injection step, and would necessarily cook the egg (which is not even required by present claims 1 and 2). See e.g., MPEP §2144.06 ("In order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents."). Accordingly, this rejection must be withdrawn.

Conclusion

In view of the above, it is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

No fee is incurred by this paper.

Respectfully submitted,

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Enclosure: PTO-1449 (Copy of dictionary definition)